

REMARKS

No claims are cancelled and claim 23 is amended. New claims 31-32 are added. Claims 23-32 are pending.

Claim 23 is directed to a carbide cathode associated with an implantable medical device. The carbide cathode includes “a titanium substrate” and “a layer of titanium carbide disposed on a surface portion of said substrate, the carbide formed from carbonaceous material.” The United States Patent & Trademark Office (USPTO) rejects claims 23-27 under 35 U.S.C. §102(b) based upon US 2001/ 0026850 by Shah et al. Applicant amended claim 23 to indicate that the carbide cathode is associated with an implantable medical device. The USPTO admits that Shah does not disclose a capacitor within an implantable medical device; therefore, the rejection of claims 23-27 should be withdrawn.

Claims 28-30 are rejected under 35 U.S.C. §103(a) based upon Shah in view of U.S. Patent No. 5,709,711 issued to Fain. The cited references do not teach or suggest a layer of titanium carbide disposed on a surface portion of said substrate, the carbide formed from carbonaceous material as in the claimed invention. Furthermore, Applicant respectfully asserts that the cited references are not properly combined. The case law on the motivation to combine references is summarized in KSR Int'l Co. v. Teleflex Inc., 119 Fed.Appx. 282 (Fed. Cir. 2005) [non-precedential], petition for cert. filed, 2005 WL 835463 (U.S. Apr. 06, 2005) (No. 04-1350).

Under our case law, whether based on the nature of the problem to be solved, the express teachings of the prior art, or the knowledge of one of ordinary skill in the art, the ***“district court was required to make specific findings as to whether there was a suggestion or motivation to combine the teachings of Asano with an electronic control in the particular manner claimed by claim 4 of the '565 patent. See Kotzab, 217 F.3d at 1371; Rouffet, 149 F.3d at 1357. . . . The district court correctly noted that the nature of the problem to be solved may, under appropriate circumstances, provide a suggestion or motivation to combine prior art references. However, the test requires that the nature of the***

problem to be solved be such that it would have ***led a person of ordinary skill in the art to combine the prior art teachings in the particular manner claimed.*** See Rouffet, 149 F.3d at 1357.

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Neither do we agree with the district court's reliance on the express teachings of the Smith patent. This is because the statement in the Smith patent that "the pedal assemblies must not precipitate any motion in the connecting wires," does not necessarily go to the issue of motivation to attach the electronic control on the support bracket of the pedal assembly. ***In other words, solving the problem of wire chafing is a different task than reducing the complexity and size of pedal assemblies. What is more, the Smith patent does not relate to adjustable pedal assemblies; therefore, it does not address the problem of wire chafing in an adjustable pedal assembly.***

[Emphasis added].

The USPTO asserts that the references were combined to "form the capacitor of Shah et al. in a cardioverter-defibrillator system of Fain, since such a modification would provide a system for the capacitor to operate in and would provide the system with having high capacitance and capacitance density." Essentially, the USPTO uses the Applicant's invention as a blue print to combine these references and fails to specifically explain why these references would be combined in the manner claimed. For example, the references appear to address very different problems than the present invention. Additionally, neither of the cited references achieve the capacitance of claimed invention. Therefore, the instant rejections should be withdrawn and issuance of a Notice of Allowance is respectfully requested.

Respectfully submitted,

June 8, 2006
Date

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